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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,753	10/27/2003	Jurgen Koch	238023US0X	8849

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
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EXAMINER

HARLAN, ROBERT D

ART UNIT PAPER NUMBER

1713

DATE MAILED: 06/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/692,753

Applicant(s)

KOCH ET AL.

Examiner

Robert D. Harlan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24, 26 and 27 is/are rejected.
- 7) ☒ Claim(s) 23-25 and 28-31 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-24 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arendt, U.S. Patent No. 5,236,987 (hereinafter "Arendt"); Arendt, WO 89/00173 (hereinafter "Arendt

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II") in view of Godwin et al., WO 97/39060 (hereinafter "Godwin"). Arendt teaches esters of benzoic acid having from 8 to about 12 carbon atoms in the ester moiety as coalescent agents for paint compositions and for use in the preparation of plastisols. See Arendt, Abstract; col. 1, line 35 through col. 2, line 6. Arendt further teaches the preparation of isodecyl benzoate via acid esterification. See Arendt; Examples. Arendt II teaches in analogous art (iso)decyl benzoates, their methods of preparation using various esterification esters and their use in the preparation of plastisols using PVC. See Arendt II, Abstract; pages 1-3. Arendt II further teaches the use of (iso)decyl benzoates with additives. See Arendt II, page 21. Godwin teaches in analogous art the use of C11-C14 esters of benzoic acids and phthallic acid esters as plastisols in PVC compositions. See Godwin, Abstract; pages 1 and 3.

4. Arendt, Godwin and Arendt II differ from the present invention in that Arendt does not expressly teach a mixture of isomeric decyl benzoates and predetermined amounts of decyl benzoates. The basic requirements of prima facie case of obvious are: (1) there must be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the

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reference or to combine reference teachings; (2) there must be a reasonable expectation of success; (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP 2143. "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (emphasis added). "In considering the disclosure of a reference, it is proper take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom." In re Preda, 401 F.2d 825, 826 159 USPQ 342, 344 (CCPA 1968). Although the cited references do not disclose in the working examples mixtures of benzoates at the claim percentages, based on the level of knowledge of a polymer chemist of ordinary skill in the art at the time of the present invention would be motivated to modify prior art prepared and used a composition comprising a mixture of isomeric decyl benzoates. The chemistry used to prepare the isomeric decyl benzoates (trans-esterification) is rudimentary and commonplace among polymer/organic chemist. The only obstacle required is the availability of the isomeric alcohols, which were readily

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available at time of the invention. In addition, the preparation of isomeric decyl benzoate naturally flow from the trans-esterification reaction nothing is different other than a substitution of alcohols. Furthermore, the mixture percentages only require optimization, which one of ordinary skill would have common knowledge. of the use of Such modification would be obvious because one would have is a reasonable expectation of success that a mixture of isomeric decyl benzoates as taught by the cited prior art would be similarly useful and applicable to plastisol technology. Therefore, claims 1-24 and 26-27 are deem as being unpatentable over the prior art.

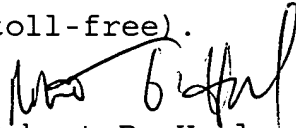
5. Claims 23-25 and 28-31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert D. Harlan whose telephone number is (571) 272-1102. The examiner can normally be reached on Mon-Fri, 10 AM - 8 PM.

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7. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David W. Wu can be reached on (571) 273-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Robert D. Harlan
Primary Examiner
Art Unit 1713

rdh